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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/823,125 | 03/30/2001 | Hernan G. Otero | 17209-341 | 6818 |
| 54205 7590 05/07/2010 CHADBOURNE & PARKE LLP 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | | |
| EXAMINER | | | | |
| OYEBISI, OJO O | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3695 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 05/07/2010 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/823,125

Applicant(s)

OTERO ET AL.

Examiner

OJO O. OYEBISI

Art Unit

3695

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) 8-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

In response to the restriction requirement mailed on 01/05/10, the applicant has elected the invention of Group I(claims 1-6 and 15-17) with traverse. The applicant argues that the restriction requirement is improper and states that the examination of all the claims in this application would not place serious burden on the examiner. Contrary to the applicant's assertion, Invention I and II have recognized divergent scope and utility and the search required for Group I is not required for Group II. There is no question that the search and the examination of the divergent Group of claims would place serious burden on the examiner. Applicant's election of Group I(claims 1-6 and 15-17) is hereby acknowledged and this restriction requirement is hereby final.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 and 15-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant recites, in claims 1 and 6, the limitation "determining by the **trade implementation plug-in** and the **market-specific plug-in** an order strategy based on the plurality of trade parameters." The specification as originally filed does not provide support for this limitation. The

examiner searched the length and breadth of the applicant's specification, but failed to find a single paragraph where support for this limitation is cited. Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 15-17 are rejected under 35 U.S.C 102(e) as being anticipated by Kane (U.S. Patent 6,317,728).

Re claim 1. Kane discloses a processor-implemented trading method, comprising: receiving via a processor a plurality of trade parameters, the plurality of trade parameters characteristic of a desired trade (see the abstract); receiving a selection of a trade implementation plug-in (see the abstract); loading the selected trade implementation plug-in in a logic engine (see the abstract); loading a market-specific plug-in in the logic engine (see the abstract); providing the plurality of trade parameters characteristic of the desired trade to the logic engine (see fig.1 element 16); determining by the trade implementation plug-in and the market-specific plug-in an order strategy based on the plurality of trade parameters (i.e., the decision logic having a plurality of

agents, each operating in response to a respective buy/sell rule for generating buy/sell orders for securities in conformance with the buy and sell data, see col.3. lines 30-34); executing the order strategy (see col.3 lines 40-43); and providing order data based on the order strategy for display in real time on a graphical user interface (i.e., a single screen for quote and position information, see col.8 lines 30-31).

Re claims 2 and 3: Kane discloses the method wherein the step of inputting a trading order into a logic engine further comprises inputting an order through an ordering system (i.e., data acquisition system, see abstract).

Re claim 5: Kane further discloses the method wherein the step of executing said order further comprises outputting said order through an ordering system (col. 3, lines 34-36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4, 6, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kane (U.S. Patent 6,317,728) in view of Microsoft Computer Dictionary (MCD hereinafter: Microsoft Computer Dictionary 5th edition, page 345).

Re claim 4: Kane discloses a method for computerized trading comprising: the steps of processing trading orders (see abstract). Kane does not explicitly disclose a step of deconstructing said Complex Order into at least one event and action. However, the method of deconstructing complex order into event/action is old and well known and it a well-taught modular design method in object-oriented modular programming (see Microsoft computer dictionary 5th edition, page 345). Therefore, it would have been obvious to one of ordinary skill in the art to implement this well-taught modular design method in Kane to allow programmers to debug and recover very quickly from program crashes.

Re claims 6, 15-17: Kane discloses the method for computerized trading comprising: , comprising: receiving via a processor a plurality of trade parameters, the plurality of trade parameters characteristic of a desired trade and received as a complex order and received through an ordering system (see the abstract); receiving a selection of a trade implementation plug-in (see the abstract); loading the selected trade implementation plug-in in a logic engine (see the abstract); loading a market-specific plug-in in the logic engine (see the abstract); providing the plurality of trade parameters characteristic of the desired trade to the logic engine (see fig.1 element 16); determining by the trade implementation plug-in and the market-specific plug-in an order strategy based on the

plurality of trade parameters (i.e., the decision logic having a plurality of agents, each operating in response to a respective buy/sell rule for generating buy/sell orders for securities in conformance with the buy and sell data, see col3. lines 30-34); executing the order strategy (see col.3 lines 40-43); and providing order data based on the order strategy for display in real time on a graphical user interface (i.e., a single screen for quote and position information, see col.8 lines 30-31). Kane does not explicitly teach the step of deconstructing said complex order into events and actions. The method of deconstructing complex order into event/action is a well-taught modular design in object-oriented modular programming (see Microsoft computer dictionary 5th edition, page 345). Therefore, it would have been obvious to one of ordinary skill in the art to implement this well-taught modular design method in Kane to allow programmers to debug and recover very quickly from program crashes.

Response to Arguments

Applicant's arguments filed 04/06/09 have been fully considered but they are not persuasive. In the remarks, the applicant argues in substance that Kane fails to disclose "determining by the trade implementation plug-in and the market-specific plug-in an order strategy based on the plurality of trade parameters." Contrary to the applicant's assertion, the examiner contends that Kane makes this disclosure (i.e., the decision logic having a plurality of agents, each operating in response to a respective buy/sell rule for generating buy/sell orders for securities in conformance with the buy and sell data, see col3. lines 30-34).

The applicant further argues that the prior art of record fail to disclose "the step of deconstructing said complex order into events and actions." Contrary to the applicant's assertion, the examiner contends that the method of deconstructing complex order into event/action is a well-taught modular design in object-oriented modular programming (see Microsoft computer dictionary 5th edition, page 345). And one of ordinary skill in the art, at the time of the invention, would have been motivated to implement this well-taught modular design method in Kane to allow programmers to debug and recover very quickly from program crashes.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571)272-8594. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/
Primary Examiner, Art Unit 3695